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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

9400-44

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on May 3, 2006

Signature

Typed or printed name

Carey Gregory

Application Number

10/646,962

Filed

08/25/2003

First Named Inventor

Wei Zhao

Art Unit

2688

Examiner

Julie E. Stein

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 48,441

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Laura M. Kelley

Typed or printed name

919-854-1400

Telephone number

May 3, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

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*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket No. 9400-44

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application: Wei Zhao et al

Confirmation No.: 3021

Application No.: 10/646,962

Group Art Unit: 2688

Filed: August 25, 2003

Examiner: Julie E. Stein

For: METHODS, SYSTEMS AND COMPUTER PROGRAM PRODUCTS FOR
DIRECTING A USER TO A WIRELESS NETWORK ACCESS POINT

Date: May 3, 2006

Mail Stop AF

Commissioner for Patents

Box 1450

Alexandria, VA 22313-1450

**REASONS IN SUPPORT OF APPLICANTS'
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program.

It is not believed that an extension of time and/or additional fee(s) is due. However, if any fee or extension of time for this request is required, Applicants request that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee which may be required, or credit any refund, to our Deposit Account No. 50-0220.

REMARKS

Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of Claims 1-7 and 9-22, which stand finally rejected under 35 USC §103(a) over U.S. Patent Application Publication 2005/0203873 to Gray ("Gray") in view of U.S. Patent Application Publication 2005/0136949 to Barnes ("Barnes"). Applicants respectfully submit that there is no motivation to combine the references, and even if the references are combined, all of the claim recitations of the independent claims are not described or suggested, so that one or more elements needed for a *prima facie* rejection under 35 USC §103(a) are not present. Therefore, Applicants respectfully request review of the present application by an appeal

conference prior to filing of an Appeal Brief. In the interest of brevity, and without waiving the right to argue additional grounds should this Request be denied, Applicants will point out the Action's omission of one or more essential elements needed for a *prima facie* rejection.

Claim 1 recites as follows:

1. A method for directing a mobile user to a wireless network access point comprising:
 - receiving a mobile user request for a location of a wireless network access point via a user terminal, wherein the user request comprises non-communication amenities;
 - identifying a geographic location of the mobile user responsive to receiving the user request; and
 - identifying a wireless network access point convenient to the user that provides access to the non-communication amenities.

Gray proposes a system in which a WAN user is informed of nearby WLAN access points. *See* Gray, Abstract. The Action concedes that Gray does not teach a user request comprising non-communication amenities or that the access point convenient to the user provides access to the non-communication amenities. However, the Action takes the position that Barnes "teaches a system in which a mobile user identifies various points of interest (non-communication amenities) using access points via a mobile device" in paragraphs 41, 94-96 and Figure 4 of Barnes.

Paragraph 41 of Barnes merely discusses various networks, standards, formats and protocols, including WLAN and mobile phone networks. Paragraphs 94-96 and Figure 4 of Barnes discuss a location module that can determine a "relative location," *e.g.*, the location of the device relative to a point of interest. Barnes discusses the location of product vendors as examples of a "point of interest." However, Barnes conveys information about points of interest to the user via an established communication link. *See* Barnes, paragraph 96 ("relative location data is determined from the device's 101 communications with access points that form part of a WLAN"). Therefore, Barnes does not teach identifying a wireless network access point that provides access to the non-communication amenities as recited in Claim 1.

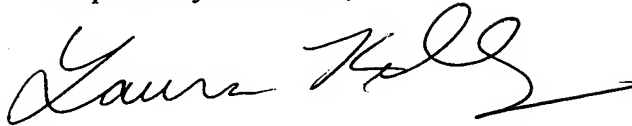
Moreover, there is no motivation to combine Gray and Barnes. The Action states that it would have been obvious to modify Gray to include the functionality of identifying access points that also provide access to non-communication amenities because users and vendors benefit from the ability to enhance their interaction through location based services. *See* the Action, page 3, citing paragraphs 6-8 of Barnes. Applicants submit that the standard of obviousness is not whether, in hindsight, someone would have combined elements to form the invention. In particular, Gray makes no mention of non-communication vendors, and as discussed above, Barnes conveys information about vendors via an established communication link. Therefore, there is no need in Barnes to locate a WLAN network as proposed by Gray.

In addition, Barnes teaches away from directing a user to a particular WLAN network as proposed by Gray. The device of Barnes automatically selects a communication network from more than one available network using programmed rules, which take into account user activity or anticipated user activity. *See* Barnes, paragraphs 60, 64 and 65. Barnes discusses that these programmed rules for selecting a network can be designed to provide a desirable result, such as increasing efficiency, reducing costs, and/or increasing throughput. *See* Barnes, paragraph 64. Barnes also discusses that the device includes programming for switching communication networks, such as when a network fails or slows down. *See* Barnes paragraph 68. In contrast to the automated selection of a network in Barnes, in Gray, the user must locate and access the WLAN access point based on directions transmitted to the user's mobile device. *See* Gray, paragraphs 10 and 38.

For the reasons discussed above, Applicant submits that one or more elements needed for a *prima facie* rejection under 35 USC §103(a) are not present. Therefore, Applicant respectfully requests that the present application be reviewed and reversed by the appeal conference prior to the filing of an appeal brief.

Attorney Docket No. 9400-44
Application Serial No. 10/646,962
Filed: August 25, 2003
Page 4

Respectfully submitted,

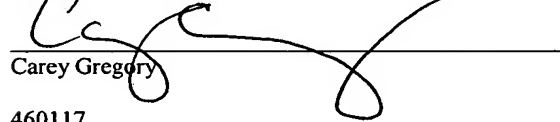


Laura M. Kelley
Registration No.: 48,441

USPTO Customer No. 39072
Myers Bigel Sibley & Sajovec
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: 919/854-1400
Facsimile: 919/854-1401

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Carey Gregory

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